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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/650,742	08/30/2000	Tsuneaki Ishimura	JEL 31237	2447
7590	12/29/2004		EXAMINER	
Stevens Davis Miller & Mosher LLP 1615 L Street NW Suite 850 Washington, DC 20036			VENT, JAMIE J	
			ART UNIT	PAPER NUMBER
			2616	

DATE MAILED: 12/29/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

09/650,742

Applicant(s)

ISHIMURA ET AL.

Examiner

Jamie Vent

Art Unit

2616

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 14 July 2004.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-20 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-20 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received..
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- ☐ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_.
- ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_.
- ☐ Notice of Informal Patent Application (PTO-152)
- ☐ Other: \_\_\_\_\_.

## DETAILED ACTION

### Response to Arguments

The following is the response to arguments for claims 1-20 dated July 14, 2004.

On Pages 12-17 applicant has argued that on Page 6 Lines 25- Page 7 Lines 9 of applicant's specification allows one to determine how the set of bit signals are compared for distinguishing the recording/reproducing apparatus' reproduction or recording modes. The examiner agrees that the specification discloses the information for comparing the bit signals; however, applicant fails to show the comparing of the two bit streams in Figure 1. It is described on Page 6 Lines 25-29 that the "the detected bit signal is compared with the multiplexed bit signal (multiplexed by synthesizing portion 111)"; however, Figure 1 fails to show an input signal being sent into the CPU 115 from the synthesizing portion 111 for comparison. In fact all that is shown is a one directional line from the CPU to the output portion 110. Therefore, due to the lack of a communication from the synthesizing portion and the CPU the examiner does not see how a comparison of two bit signals can be done considering only one bit signal, reproduction input signal, is entering into the apparatus. While all of the above applicant's points are understood, the examiner cannot agree. Therefore this rejection is maintained.

### ***Claim Rejections - 35 USC § 112***

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the

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art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 1-20 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claim(s) contains subject matter, which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention.

In view of the disclosure one skilled in the art cannot make and use the invention due to no details on how to one discriminates whether the recording/reproducing apparatus is in a recording mode or reproduction mode. The specification states on Page 6 Line 25 – Page 7 Line 9 “ When bit signal is detected the detected bit signal is compared with the multiplexed bit signal (multiplexed by synthesizing portion 111) (step 2). When the bit signal cannot be detected or when the detected bit signal and the set bit signal continuously coincide by a length of a few fields, the video switching apparatus is set to the recording mode (step 3 and 5). When the detected bit signal and the set bit signal do not coincide, the video switching apparatus 1011 is set to reproducing mode (steps 3 and 4)”.

The lacking details of continuously coinciding with set bit by “a few fields” does not allow examiner to understand how the bit signal is compared to determine reproduction or recording mode and thereby ultimately determining the position of the video switch. Although, illustration of the apparatus in Figure 1 element 105 and method in Figure 2 Step 2 & 3 the lacking details in the specification and claims <sup>does not</sup> enable ~~one skilled in the art~~ <sup>examiner</sup> to make or use the invention.

### **Conclusion**

**THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.

### **Contact Fax Information**

*Any response to this action should be mailed to:*

Commissioner of Patents and Trademarks  
Washington, DC 20231

*Or faxed to:*

703.208.6306 (for formal communication intended for entry)  
703.308.5359 (for informal or draft communications, please label "PROPOSED"  
or "DRAFT")

*Hand-delivered responses should be brought to Crystal Park II, 2121 Crystal Drive, Arlington, VA., Sixth Floor (Receptionist).*

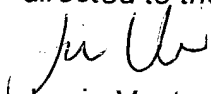
### **Contact Information**

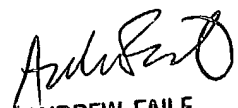
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*Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jamie J. Vent whose telephone number is (703) 305-0378.*

*If any attempts to reach the examiner by telephone are unsuccessful, the examiners supervisor, Christopher Kelley, can be reached at (703) 305-4856.*

*Any inquiry of a general nature or relating to the status of this application should be directed to the Group receptionist whose telephone number is (703) 305-4700.*

  
Jamie Vent  
12/22/04

  
ANDREW FAILE  
SUPERVISORY PATENT EXAMINER  
TECHNOLOGY CENTER 2600